

Patricia L. Peden, Esq. (SBN 206440)
ppeden@bwslaw.com
BURKE, WILLIAMS & SORESENSEN, LLP
1999 Harrison Street, Suite 1650
Oakland, CA 94612
Phone: (510) 273.8780
Fax: (510) 839.9104

Christopher J. Lee (*Pro Hac Vice*)
clee@leesheikh.com
David J. Sheikh (*Pro Hac Vice*)
dsheikh@leesheikh.com
Brian E. Haan (*Pro Hac Vice*)
bhaan@leesheikh.com
Ashley E. LaValley (*Pro Hac Vice*)
alavalley@leesheikh.com
James D. Mitchell (*Pro Hac Vice*)
jtmitchell@leesheikh.com
LEE SHEIKH & HAAN LLC
125 South Clark Street, Suite 1175
Chicago, IL 60603
Phone: (312) 982-0070
Fax: (312) 982-0071

Attorneys for Plaintiff
MPH TECHNOLOGIES OY

BITA RAHEBI (SBN 209351)
brahebi@mofo.com
RYAN J. MALLOY (SBN 253512)
rmalloy@mofo.com
ROSE S. LEE (SBN 294658)
roselee@mofo.com
NIMA KIAEI (SBN 336142)
nkiaei@mofo.com
Morrison & Foerster LLP
707 Wilshire Boulevard
Los Angeles, California 90017
Telephone: (213) 892-5200
Facsimile: (213) 892-5454

RICHARD S.J. HUNG (SBN 197425)
rhung@mofo.com
Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105
Telephone: (415) 268-7000
Facsimile: (415) 268-7522

Attorneys for Defendant
APPLE INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

MPH TECHNOLOGIES OY,

Plaintiff,

vs.

APPLE INC.,

Defendant.

Case No. 3:18-cv-05935-TLT

~~[PROPOSED]~~ PARTIAL
STIPULATED JUDGMENT AND
ORDER ON UNITED STATES
PATENT NOS. 8,346,949, 9,762,397,
9,712,494, 9,712,502, 9,838,362 AND
7,937,581

Judge: Hon. Trina L. Thompson

WHEREAS, this is a patent infringement action brought by plaintiff MPH Technologies Oy
("MPH") against defendant Apple Inc. ("Apple");

1 WHEREAS, this Court has jurisdiction over the claims in this action pursuant to 28 U.S.C. §§
2 1331 and 1338;

3 WHEREAS, MPH has asserted that Apple infringes (a) claims 1, 3, 9, 11, 12, 13, and 28 of
4 United States Patent No. 8,346,949; claim 1 of United States Patent No. 9,762,397; claims 2, 4, 9, and
5 11 of United States Patent No. 9,712,494; claims 7–9 of United States Patent No. 9,712,502; and claims
6 3, 5, 10, 12–14 and 16 of United States Patent No. 9,838,362 (collectively, “the ’949 patent family”);
7 (b) Claims 6–8 of United States Patent No. 7,937,581 (“the ’581 patent”); and (c) claims 1–6, 9–11,
8 13, and 16 of United States Patent No. 8,037,302 (“the ’302 patent”);

9 WHEREAS, Apple denies infringement, and has asserted a number of affirmative defenses and
10 counterclaims, including that the asserted claims of the patents in suit are invalid;

11 WHEREAS, on January 3, 2024, this Court issued an *Order Construing Claims* (Dkt. No. 109),
12 which sets forth its claim construction of nine (9) disputed claim term groups;

13 WHEREAS, this Court’s *Order Construing Claims* adopted Apple’s proposed constructions for
14 the “secure” terms and the “unique identity” term of the ’949 patent family;

15 WHEREAS, this Court’s *Order Construing Claims* found the “establishing a secure
16 connection” term of all asserted claims (claims 6–8) of the ’581 patent to be indefinite;

17 WHEREAS, MPH cannot meet its burden of proof of infringement of the ’949 patent family
18 under the Court’s constructions of either the “secure” terms or the “unique identity” term as set forth
19 in the Court’s January 3, 2024 *Order Construing Claims* and cannot proceed with its claim of
20 infringement for all asserted claims of the ’581 Patent because of this Court’s rulings in its *Order*
21 *Construing Claims* and *Order Amending Portion of Order Construing Claims As To the ’581 Patent*
22 *Claims 6, 7 and 8* that the “establishing a secure connection” term of the ’581 patent is indefinite and
23 that “the language in the ’581 Patent Claims 6, 7, and 8 is indefinite”;

24 WHEREAS, on August 16, 2024, this Court issued an *Order Amending Portion of Order*
25 *Construing Claims As To the ’581 Patent Claims 6, 7 and 8* (Dkt. No. 149) holding that “Apple has
26 shown by clear and convincing evidence that the Claim Language, viewed in light of the Specification
27 and Prosecution History, support a finding that the language in the ’581 Patent Claims 6, 7, and 8 is
28 indefinite”;

1 WHEREAS, MPH respectfully disagrees with the Court's constructions of the "secure" terms
2 and the "unique identity" term of the '949 patent family in the *Order Construing Claims* (Dkt. No.
3 109);

4 WHEREAS, MPH respectfully disagrees with this Court's finding in its *Order Construing*
5 *Claims* (Dkt. No. 109) that the "establishing a secure connection" term of the '581 patent is indefinite;

6 WHEREAS, MPH respectfully disagrees with this Court's holding in its *Order Amending*
7 *Portion of Order Construing Claims As To the '581 Patent Claims 6, 7 and 8* (Dkt. No. 149) that "the
8 language in the '581 Patent Claims 6, 7, and 8 is indefinite";

9 WHEREAS, MPH agrees, without prejudice to an appeal and its right to reinstatement of its
10 claim of infringement in the event of remand, vacatur, reversal or any other outcome favorable to MPH
11 by the United States Court of Appeals for the Federal Circuit for further proceedings on its claim of
12 infringement of the '949 patent family, that it cannot presently meet its burden of proof of infringement
13 of the '949 patent family under this Court's construction of the claim terms as set forth in the Court's
14 January 3, 2024 *Order Construing Claims*;

15 WHEREAS, MPH agrees, without prejudice to an appeal and its right to reinstatement of its
16 claim of infringement of the '581 patent in the event of remand, vacatur, reversal or any other outcome
17 favorable to MPH by the United States Court of Appeals for the Federal Circuit for further proceedings,
18 that it cannot presently proceed with such claim of infringement because of this Court's rulings in its
19 *Order Construing Claims* and *Order Amending Portion of Order Construing Claims As To the '581*
20 *Patent Claims 6, 7 and 8* that the "establishing a secure connection" term of the '581 patent is indefinite
21 and that "the language in the '581 Patent Claims 6, 7, and 8 is indefinite," respectively;

22 WHEREAS, Apple agrees to dismiss, without prejudice, its affirmative defenses and
23 counterclaims directed to the '949 patent family with the right to reassert them in the event the judgment
24 of non-infringement on the '949 patent family is remanded to the Court after appeal;

25 WHEREAS, Apple agrees to dismiss, without prejudice, its affirmative defenses and
26 counterclaims directed to the '581 patent that are not addressed in this Court's rulings in its *Order*
27 *Construing Claims* and *Order Amending Portion of Order Construing Claims As To the '581 Patent*
28 *Claims 6, 7 and 8* with the right to reassert them in the event the judgment of invalidity on the '581

1 patent is remanded to the Court after appeal;

2 WHEREAS, this Partial Stipulated Judgment does not, and is not intended to, address MPH's
3 claim of infringement of the '302 patent and Apple's affirmative defenses and counterclaims with
4 respect to United States Patent No. 8,037,302; and

5 WHEREAS, this stipulation does not impact the parties' claims, defenses and counterclaims
6 relating to United States Patent No. 8,037,302;

7 IT IS HEREBY ORDERED that this Partial Stipulated Judgment is entered in favor of Apple
8 and against MPH on MPH's claim that Apple infringes the '949 patent family subject to and without
9 prejudice to an appeal and MPH's right to reinstatement of its claim of infringement in the event of
10 remand, vacatur, reversal or any other outcome favorable to MPH by the United States Court of Appeals
11 for the Federal Circuit;

12 IT IS HEREBY ORDERED that this Partial Stipulated Judgment is entered in favor of Apple
13 and against MPH on Apple's counterclaim that Claims 6, 7 and 8 of the '581 patent are indefinite and,
14 thus, invalid under 35 U.S.C. § 112 subject to and without prejudice to an appeal and MPH's right to
15 reinstatement of its claim of infringement in the event of remand, vacatur, reversal or any other outcome
16 favorable to MPH by the United States Court of Appeals for the Federal Circuit;

17 IT IS HEREBY ORDERED that this Partial Stipulated Judgment adjudicates fewer than all the
18 claims or the rights and liabilities of the parties as provided in Fed.R.Civ.P 54(b), and, when the Court
19 enters final judgment on all remaining claims, defenses, and counterclaims in this action, will become
20 an appealable final judgment that is subject to the same right of appeal that MPH would have in the
21 event a final judgment of non-infringement of the '949 patent family and invalidity due to indefiniteness
22 of the '581 patent had been entered following either a dispositive ruling by the Court or a jury verdict
23 due to the Court's claim constructions of claim terms of the '949 patent family and the '581 patent in
24 its *Order Construing Claims* and *Order Amending Portion of Order Construing Claims As To the '581*
25 *Patent Claims 6, 7 and 8*; and

26 IT IS FURTHER ORDERED that Apple's affirmative defenses and counterclaims with respect
27 to the '949 patent family and the '581 patent are dismissed without prejudice to Apple's right to reassert
28 its defenses and counterclaims in the event of remand or any other assertions by MPH under those

1 patents.

2 **IT IS SO STIPULATED.**

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5 Dated: September 23, 2024

Respectfully submitted,
/s/ Christopher J. Lee

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7 Attorneys for Plaintiff
MPH TECHNOLOGIES OY

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BURKE, WILLIAMS & SORENSEN, LLP

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LEE SHEIKH & HAAN LLC

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13 Dated: September 23, 2024

Respectfully submitted,
/s/ Bitra Rahebi

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15 Attorneys for Defendant
APPLE INC.

16
17 Bitra Rahebi (SBN 209351)
BRahebi@mofo.com
MORRISON & FOERSTER LLP
707 Wilshire Boulevard
Los Angeles, California 90017-3543
Telephone: 213.892.5200
Facsimile: 213.892.5454

18
19 Richard S.J. Hung (SBN 197425)
RHung@mofo.com
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: 415.268.7000
Facsimile: 415.268.7522

ATTESTATION OF CONCURRENCE IN FILING

Pursuant to Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this document has been obtained from each of the signatories listed above.

Dated: September 23, 2024

/s/ Christopher J. Lee

PURSUANT TO STIPULATION, IT IS SO ORDERED.

Dated: September 25, 2024

A handwritten signature in dark ink, appearing to read "Trina Thompson", written over a horizontal line.

Honorable Trina Thompson
United States District Judge